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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,406	11/03/2000	James P. Tagg	SC-TAG-102	7866
69296	7590	12/16/2011		
VON SIMSON & CHIN 62 WILLIAM STREET, 6TH FLOOR NEW YORK, NY 10005			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2442	PAPER NUMBER
			MAIL DATE 12/16/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/706,406

**Applicant(s)**

TAGG, JAMES P.

**Examiner**

DOUGLAS BLAIR

**Art Unit**

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 21-26, 28-45 and 48 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 21-26, 28-45 and 48 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

The rejections based on 35 USC section 112 1st paragraph of claim 27, 29, and 34 have been withdrawn with respect to claim

The rejections based on 35 USC section 112 2nd paragraph are withdrawn in view of the applicant's amendments.

***Response to Arguments***

Applicant's arguments filed 10/17/2011 have been fully considered but they are not persuasive.

With respect to the first part of the rejection of claim 21 based on 35 USC section 112 1st paragraph, the applicant's arguments are not persuasive and the limitation in question is now rejected as claim 48. The applicant is arguing that because the client can allegedly access the host with the CTA program without authentication that the claim language in question is supported. This argument is not persuasive because the limitation in question deals with connecting to the target network and not the intermediate host. The applicant has not shown an embodiment where an authentication to the target system is not performed when the target system is accessed.

With respect to the second part of the rejection of claim 21 based on 35 USC section 112 1st paragraph, the applicant's arguments are not persuasive. The applicant's specification may have disclosed software common to the client and the host system however the applicant's specification did not disclose that this software prevented the client from accessing resources.

The software may not have been designed to provide access to host resources but there is no disclosure that the hardware explicitly prevents this access. The Examiner is maintaining this rejection because the applicant has argued that this is a patentably distinguishing feature in the past. The Examiner cannot grant a patent for a feature that does not advance the state of the art and the applicant's disclosure provides no technology regarding the "prevention" limitation that would advance the state of the art.

With respect to claim 31, the Examiner can see how the cited portion of the specification provides time divided channels for transmitting data but there is no disclosure of time dividing any specific data.

With respect to the prior art rejection based on Rai, the applicant's arguments are not persuasive. The Examiner provided the applicant with the following guidance on amending the claims via email on 10/6/2011:

I've considered the claims and I think there are a couple of things I'd like to see.

One way to differentiate from the prior art would be to specify in the claim that the host system has software which corresponds to that of the client CTA. Figure 6 shows how the CTA software is present at both the client and the host and page 17 explains how the CTA software on the host and client is the "same".

The second way is to amend the claims to reflect that the host is a peer device (has a browser for example). The way the claims read now, I was just seeing a standard type of tunneling host (like Rai) and not a peer connection concept.

The Examiner assumed that the applicant would actually claim details of how the host system software corresponds to that of the client CTA. The Examiner did not think that the applicant would take this to mean that only adding the word "corresponding" would distinguish the claims over the prior art. The plain meaning of the word "corresponding" clearly does not patentably distinguish over Rai because in the Rai the software on the mobile device has to

"correspond" to the foreign agent software in some manner, otherwise the two pieces of software would know how to communicate and no connection to the home network could ever be reached. The applicant's amendment clearly does not distinguish the claims from Rai.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-45 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's claims are rejected for two reasons under 35 USC section 112 1st paragraph.

First, the applicant's specification states the following:

Upon access by a mobile member, the CTA sends both identifiers and status information to a server. The server contains preference information on all members that can be referenced by their identifiers. The status information is compared to the preferences of the two members and, if the comparison is successful, a link to the Internet is provided to the mobile member.

In the applicant's disclosed invention, only when the host device supplies a proper identifier, is the link provided. Therefore the host device is authenticated to the target computer. The host device may not be supplying its own credentials but the claims are not that specific. The applicant's disclosure does not provide written description support for the claimed limitation

of "a step of connecting the client system to the target network via a host system controlled by the software provided in the client system without needing to authenticate said host system to said target system".

Second, the applicant's specification does not provide support for the newly amended limitation of "wherein said client software is prevented from accessing resources outside of said tunnel in said host system". The applicant's remarks from 4/18/2011 state that support for this limitation can be found in at least paragraphs 27 and 28 of the applicant's specification. The applicant's originally filed disclosure does not have paragraph numbers and has not been published so it is not clear what paragraphs the applicant is referring to.

There is no disclosure of any form of "prevention" in the applicant's specification. Instead the applicant disclosed client software that is designed in such a way that it does not access resources of a host system. Though the applicant's client software does not access the resources of the host system, the applicant has not disclosed any elements that explicitly prevent the client from access resources at the host system.

Claim 31 is rejected because the applicant's originally filed disclosure did not mention channels which transmit time divided data. This limitation first appeared in the amendment filed on 8/10/2005.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-26, 28-31, 33-36, 38, 40, 41, 44, and 48 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,377,982 to Rai.

Claims 21-26, 28-31, 33-36, 38, 40, 41, 44, and 48 are rejected according to the same embodiments of Rai cited in the last action in view of the Examiner's statements made in the Response to Arguments section of this action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 37, 39, 42, 43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,377,982 to Rai.

Claims 32, 37, 39, 42, 43, and 48 are rejected according to the rationale explained in the previous office action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/  
Primary Examiner, Art Unit 2442